

## Remarks

The claims are 1-14. Claims 1, 5, 6, 11, 12, and 13 have been amended to recite that the film coated liquid implant is formed by injecting the compositions into a tissue of a subject in need of such implant. Support for this recitation can be found in the original specification at, for example, page 26, line 10. Accordingly, the changes are not new matter.

### I. Rejections over US. Patent No. 5,792,469 ("Tipton"):

Claims 1-14 have been rejected as allegedly being anticipated by Tipton. The claims have been amended to overcome the rejections.

Applicants respectfully submit that Tipton does not disclose formation of a film coated liquid implant by injecting a composition into a tissue of a subject in need of such implant. Tipton forms a film or a caulk of a composition onto a surgically implanted device (column 13, lines 50 to column 14, line 7, cited by the Examiner). The Tipton composition can be applied by methods that include a syringe – but to the implantable device. That device is implanted through surgery and the composition is applied to the device during that surgery (as described by the Tipton examples). Nowhere in Tipton is there disclosure of injection the composition into a tissue of the subject as presently claimed by this application, as amended.

There is also no suggestion or teaching in Tipton of such injection into a tissue of the subject. Accordingly, the present claims, as amended, is not anticipated or made obvious by Tipton. Applicants respectfully request withdrawal of the rejections.

### II. Rejections Over US. Patent No. 6,136,838 ("Chern"):

Applicants respectfully submit herewith a terminal disclaimer to overcome the judicially created doctrine of double patenting rejection over Chern. Accordingly, Applicants request withdrawal of the rejections.

### Conclusion

Applicants respectfully submit that the application is in condition for allowance because all the rejections have been overcome and request a Notice to that effect.

If a telephonic discussion would be helpful to further the prosecution, Applicants' attorney can be reached at the telephone number below. Correspondence should continue to be directed to the address below. Any deficiencies in fees should be charged to Deposit Account 13-2755.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

MERCK & CO., INC.

By Shu M. Lee Date May 21, 2001

Date: May 21, 2001

Respectfully submitted,

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